

Appl. No.: 09/913,378; Group Art Unit: 1731

Response dated October 18, 2007

Reply to April 27, 2007 Office Action and Advisory Action dated September 12, 2007

Remarks

Submission of RCE

A Request for Continued Examination is respectfully submitted.

According to the Examiner, Applicants' Amendment of August 27, 2007 was not entered into the record on the basis that the proposed Amendment was not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Applicants respectfully disagree with this position.

By way of this Submission, Applicants present the non-entered Amendment of August 27, 2007 for a full and fair consideration on the merits, and respectfully request that the Examiner kindly withdraw the Final Rejection and fully consider the amended claims and arguments submitted herewith over the prior art.

Claim Status

Claims 10-35 are pending in the application and are rejected. Claims 28, 31 and 34 have been amended to recite that the emulsion is "consisting essentially of" the specified components, as with a previous amendment to Claim 10. The preambles of Claims 10, 28, 31 and 34 have been amended to include the substrates having a soft and moist feel. Basis is provided at page 24, line 18 and Table 1 at page 25. These amendments are directed to amendments and arguments previously made, and are considered to place all of the claims in condition for allowance.

Examiner's Remarks in Advisory Action

According to the Examiner, the independent claims do not "contain any relative amount of the different components that make up the emulsion. Applicants have not shown that the composition would work just for the mere presence of the components

in the emulsion, even if all or some of them were added at infinitesimal proportions, i.e., close to Zero% (0%). Without the operational range in the independent claim, it cannot be considered that the emulsion would produce a moist tissue.”

It is not at all clear to Applicants as to what is the statutory or legal basis for this new requirement by the Examiner that amounts of the respective components be recited in the independent claims.

What is the statutory basis for this requirement? It is not stated in the Advisory Action.

The Examiner cites no case law. Nor does the Examiner cite any section of the M.P.E.P. to support his position that amounts of components must be recited in the independent claims.

Taking the Examiner's position to the extreme, no patents would issue without a specific recitation of the amounts of the components in the independent claims. Obviously, such is not the case. Patents are issued all the time without specific numerical limitations in the main claims.

In this instance, the specification describes at page 6, lines 25-30 and page 7, lines 1-2 the respective range of amounts suitable for use in making the substrates of the invention. This is more than adequate teaching to one of skill in the art as to how to achieve the substrates of Applicants' invention. Based on this teaching, one of skill in the art with routine experimentation can readily determine other amounts that may also be suitable to make the substrates of the invention. However, Applicants, without some basis in the law, should not need or be required to unduly limit the scope of their invention to the point where mere minor changes by a 3rd party of the amounts of the components recited in the independent claims, as suggested by the Examiner, would render any patent issued herein virtually unenforceable and readily designed around.

The Examiner is kindly requested to reconsider his position in this regard.

Rejection under 35 U.S.C. § 103(a)

Claims 10-35 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,207,014 (de Haut). The Examiner raises three (3) issues with respect to the rejection, which are discussed hereinafter.

1. According to the Examiner, there is no distinction between de Haut's substrate having a "dry feel" and the claims of the present invention wherein the substrates have a "moist feel."

In the previous Response, Claims 10, 28, 31, and 34 were amended to recite that the process of the invention provides a "moist" paper substrate. The substrates made by way of the invention have a moist sensorial feel to the touch of the user. See Table 1 at page 25 of the specification. Thus, the term "moist" in this context means a "moist sensorial feel."

The compositions of de Haut provide a "dry feel" to the treated substrates, which "dry feel" is highly desired by de Haut, as discussed hereinafter.

At column 4, lines 52-59, de Haut discloses that:

"Other objects of the invention are to provide a composition imparting greater pliancy and a more velvety feel to the fibrous structures. **Moreover, this feel remains dry**, contrary to the case of some lotions which once impregnated for example in a paper product provide a greasy feel or deposit a grease film on the skin or on spectacles occasionally wiped by means of this kind of product, handkerchief or facial tissue (emphasis added)."

At column 9, lines 23-26, de Haut teaches that:

"Its [de Haut composition] main effect on an absorbent paper product on one hand is to impart a soft and slippery feel to the paper **which remains dry**, and on the other hand to soften the skin surface in contact with this paper (emphasis added)."

Thus, it is clear that the compositions of de Haut provide a treated substrate that is **dry to the feel or touch of the user**. Thus, the compositions of de Haut impart a **dry sensorial feel** to the treated substrates.

From the Examiner's comments in the Office Action, it is the Examiner's view that a substrate that has a "dry feel" is the same as one that has a "moist feel."

Applicants respectfully disagree with and traverse that view, and stand by their previous and present comments that, in essence, a "dry feel" and a "moist feel" are mutually exclusive.

2. According to the Examiner, "Also applicants argue that the use of [saturated] fatty acid [sic] is critical to the reference invention. While this might be true, the question is not that is critical to reference invention, but if the use of that particular component would significantly change the claimed composition, since the composition is open to other components that do not critically change the claimed composition (emphasis in original)."

It should be noted that Applicants' arguments were in regard to the teachings of de Haut as to a saturated fatty alcohol, not an acid.

With regard to Claims 10, 28, 31, and 34 (and the claims dependent there from), de Haut fails to teach or suggest an emulsion consisting essentially of: (i) a polyol poly-12-hydroxystearate; (ii) a wax ester; and (iii) a wax.

All of de Haut's compositions include a saturated fatty alcohol.

At column 6, lines 62-67, de Haut describes that:

"The length of the carbon chain of the fatty alcohol is essential with respect to applying the lotion to the surface of the fibrous structures. A sufficiently long chain allows this kind of molecule to remain at the surface of the fibrous structure, such as a sheet of paper, rather than penetrating the surface and migrate into the structure (emphasis added)."

Thus, de Haut describes that the saturated fatty alcohol remains at the surface of the fibrous structure, rather than penetrating the surface and migrating into the structure.

By way of comparison, the Examiner's attention is directed to the specification at page 3, lines 10-15 where it is disclosed that with regard to the emulsions of the invention:

"The emulsions have low viscosities, even in highly concentrated form, so that they are easy to process. By virtue of their small droplet size, **the emulsions penetrate very quickly into the tissues and are uniformly dispersed therein** (emphasis added)."

In the previous Office Action, it was the Examiner's opinion "that the use of saturated fatty acids [sic] would not materially change the composition and therefore, the cited reference still reads on the claims."

The Examiner's opinion is traversed.

As is clear from the teachings of de Haut above, **the saturated fatty alcohols of de Haut are selected so as to remain at the surface of the substrate, rather than penetrate the surface and migrate into the substrate.**

Applicants' emulsions, by way of comparison, are **designed to penetrate into the substrates very quickly and become uniformly dispersed therein.**

The addition of a component of the prior art that remains at the surface of the substrate, rather than penetrates quickly into the substrate clearly would be a **material change** to the emulsions used in the invention, **which emulsions desirably penetrate very quickly into the substrates and become uniformly dispersed therein.**

Thus, Applicants have demonstrated that the addition of de Haut's saturated fatty alcohols, which remain at the surface, would materially change the emulsions used in the claimed invention.

It is respectfully submitted that Applicants have met the legal burden of demonstrating the material change of excluding the saturated fatty alcohol of de Haut from Applicants' emulsions, pursuant to *In re De Lajarte* and *Ex parte Hoffman* (cited by the Examiner in the Office Action dated August 29, 2006).

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3. With respect to the issue of "unsaturated esters", it is reasonably believed that this issue is rendered moot by Applicants' responses to Issues 1 and 2. Nevertheless, Applicants maintain their position on this issue, as discussed in detail in the previous Response.

Summary

For the reasons presented above, it is therefore respectfully submitted that Claims 10-35 are patentable over the prior art. Reconsideration and withdrawal of the rejection are respectfully requested.

Fees

A Petition for a Three-Month Extension of Time is enclosed. No additional fees are believed due, but the Commissioner is authorized to charge (or credit any balance) any fees deemed due (or owing) to Deposit Account No. 50-1177.

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Conclusion

It is respectfully submitted that Claims 10-35 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If anything further is needed to advance the allowance of this application, the Examiner is requested to contact Applicants' attorney at the telephone number indicated below.

Respectfully submitted,

Date: October 18, 2007


John F. Daniels
Attorney for Applicants
Registration No. 34,314
Telephone: (215) 628-1413
Facsimile: (215) 628-1345
E-mail: JOHN.DANIELS@COGNIS.COM

Cognis Corporation
300 Brookside Avenue
Ambler, PA 19002

JFD/mc